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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,309	08/27/2003	Ronald W. Hartgrove	11149.0030.NPUS00	5404

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EXAMINER

LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/649,309	Applicant(s) HARTGROVE, RONALD W.	
	Examiner Jack W. Lavinder	Art Unit 3677	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum, 5133195.

Regarding claims 1, 6, 7, 8, 9, 16, 17, 20, 24, 25, 26, 27, Appelbaum discloses a jewelry item (figure 2) for an interchangeable setting (18) comprising a body (14) defining a mounting area (figure 3) for holding the setting (18), i.e. slots (36) hold the setting from moving in the vertical direction, and a module (50, 60, 70) for slidably coupling, i.e., the portion 60 slides over 34 and snaps onto portion 54 from a direction other than along the axis (horizontal axis, into and out of the page in figure 3) in which the setting is still capable of moving (figure 5), and holding the setting (18) in the mounting area (figure 3) along the one axis.

Appelbaum fails to disclose a module that is discrete from the setting. The courts have noted that it would be obvious to a person of ordinary skill in the art to have made an integral piece, i.e., the pivoting piece (50) attached and integral with the setting base piece (26), into two separable pieces. This is a matter of obvious design choice, i.e., both arrangements perform the identical function of securely mounting the setting to the mounting area of the jewelry item. Also, the specification has failed to point out any

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criticality with regards to the module being discrete from the setting. Therefore, it would have been an obvious design choice to form Appelbaum's integral module into two separate pieces that fit together.

Regarding claims 2, 3, 21, Appelbaum discloses a slotted bore (34, 36, figure 3) for receiving the arm (26) of the module (50, 60, 70).

Regarding claims 4, 5, 22, 23, Appelbaum discloses two portions on the module, i.e., the left and right ends of the module (50, 60, 70, figure 5).

Regarding claim 10, Appelbaum's mounting area, i.e., the area inbetween the posts (14) in figure 3 is defined by an imaginary circle, which has a diameter no greater than the distance between the posts.

Regarding claim 11, Appelbaum's setting (18) includes a *portion* of a disc, i.e., a flat surface area (26).

Regarding claim 12, Appelbaum discloses a recessed portion (72) in the body coupling with a portion of the module (70).

Regarding claim 13, Appelbaum discloses a recessed portion including a bridge (28).

Regarding claim 14, Appelbaum discloses a module having a slot, i.e., the slot formed between portion 70 and portion 60.

Regarding claim 15, Appelbaum discloses a bridge (28) wherein the slot fits onto the bridge (figure 5).

Regarding claims 18, 28, 30, Appelbaum discloses a biasing member (60), i.e. it biases about the end section 54 in a snap fit connection to capture the setting.

Regarding claims 19 and 29, Appelbaum discloses a snap fit connection to retain the module on the setting to prevent the setting from becoming detached from the body of the jewelry article. Appelbaum does not disclose using a magnetic fastening means to attach the module to the setting.

The examiner takes Official Notice that it is old and well known in the jewelry art to use magnetic fasteners to attach gemstones to a jewelry article. The use of either the snap connection or the magnetic coupling is considered to be an obvious design choice to a person having ordinary skill in the art. Both the mechanical fastener and the magnetic fastener both perform the same function of attaching the gemstone to the jewelry article equally as well as the other. Also, the specification is absent a showing of criticality as to the use of a magnetic fastener over a mechanical fastener.

### ***Response to Arguments***

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 703-308-3421. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W Lavinder  
Primary Examiner  
Art Unit 3677

4/2/05